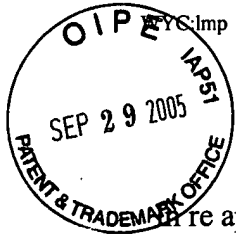


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NYC:Imp 9/27/05 60156S

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Re application of:

Rhoads et al.

Application No.: 09/547,664

Filed: April 12, 2000

For: SYSTEM FOR LINKING FROM
OBJECTS TO REMOTE RESOURCES

Examiner: V. Vu

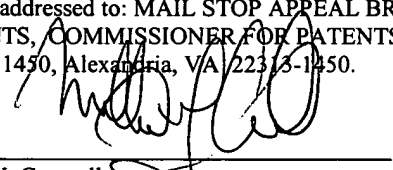
Date: September 27, 2005

Art Unit 2154

Confirmation No. 6242

CERTIFICATE OF MAILING

I hereby certify that this paper and the documents referred to as being attached or enclosed herewith are being deposited with the United States Postal Service on September 27, 2005 as First Class Mail in an envelope addressed to: MAIL STOP APPEAL BRIEF - PATENTS, COMMISSIONER FOR PATENTS, P.O. Box 1450, Alexandria, VA 22313-1450.


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TRANSMITTAL LETTER

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- ☒ Enclosed for filing in the above-captioned matter is a Reply Brief.
- ☒ If any extension of time is required, please consider this a petition therefor.
- ☒ Please charge any fees which may be required in connection with filing this document, or credit any overpayment, to Deposit Account No. 50-1071.

Date: September 27, 2005

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Respectfully submitted,

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Registration No. 31,943



WYComp 60156S 9/27/05

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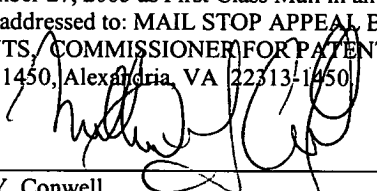
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William Y. Conwell
Attorney for Appellants

REPLY BRIEF

Mail Stop: Appeal Brief - Patents
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P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This brief is responsive to the Examiner's *Answer* mailed July 27, 2005.

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I. RELATED APPEALS AND INTERFERENCES

The *Answer* suggests that Appellants failed to address related appeals and interferences. In fact, two paragraphs in the Appeal Brief were directed to this topic. Those paragraphs noted:

Application 09/531,076 is related and was appealed. However, after consideration of applicants' Appeal Brief, the Office re-opened prosecution by issuing a new, non-final action.

(The '076 application is the parent of the present application. The specification of the '076 application is essentially identical to the spec of the present application. The claims originally filed in the '076 application are essentially identical to the claims originally filed in the present application. A restriction requirement was issued in the present application. Original claims 7-16 are pursued in the present application; original claims 1-5 are pursued in the '076 application.)

II. GROUPING OF CLAIMS

The *Answer* faults Appellants' Brief for not including a statement concerning grouping of claims that stand or fall together.

The Board will recognize that, under the new appeal procedures, an Appeal Brief no longer requires a statement concerning grouping of claims that stand or fall together. The Federal Register discussion of the new appeal practices notes:

The grouping of claims requirement set forth in former Rule 192(c)(7) is removed.¹

The Appeal Brief is in compliance with the current requirements. Contrary to the *Answer*, claims 7-16 do not stand or fall together. The reasons each is independently patentable are detailed in the Appeal Brief.

¹ Federal Register, Vol. 69, No. 155, pp. 49960, 49962.

III. CHANGED GROUNDS OF REJECTION

In the *Answer*, the grounds of rejection have been changed.

In particular, the Office has silently withdrawn the anticipation rejection of claims 15 and 16 over Moskowitz (5,822,432), and expressly made an obviousness rejection of these claims over Moskowitz in view of (newly cited) Monteiro (5,778,187).

Similarly, the Office silently has withdrawn the obviousness rejections of claims 13-16 over Doyle (5,838,906) in view of Moskowitz.

Thus, as now understood, the rejections are as follows:

Claims 7-12 remain rejected as obvious over Doyle in view of Moskowitz.

Claims 13 and 14 remain rejected as anticipated by Moskowitz.

Claims 15 and 16 are newly rejected as obvious over Moskowitz in view of Monteiro.

This *Reply* does not restate all the points made in Appellants' opening Brief concerning the appealed rejections; rather, this brief focuses on assertions newly made in the *Answer*.

IV. ARGUMENT

1. Claim 7 (§ 103: Doyle + Moskowitz)

In the *Answer*, the Office continues to cite Doyle for a limitation not present in Appellants' claim, and fails to identify in Doyle the limitation required by the claim.

In particular, the *Answer* states:

*Doyle discloses a system for embedding a tag within a html document wherein the tag is indicative of a file context or format or a program identifier, i.e., identifying a program for use to open or operate upon the document at the remote system.*²

This is not the limitation found in Appellants' claim. Appellants' claim does not require a tag or identifier indicating what program is used to open/operate upon the document at the

² Examiner's Answer, page 4, lines 12-15.

remote system. Rather, Appellants' claim requires an identifier of the program that transmits the packet of data to the remote system. Doyle has no such teaching.

Thus, even if Doyle were combined with Moskowitz, the claimed arrangement could not result.

Accordingly, the Office has presented a rejection of a combination that Appellants are not claiming. It has failed to present a rejection of the combination that Appellants are claiming.

A second shortcoming also permeates the Office's handling of claim 7 – the deficient rationale for combining Doyle and Moskowitz. Ignoring the shortcoming of Doyle noted above, but noting Doyle's failure to provide any teachings concerning watermarks (*i.e.*, the claimed "watermark detector," "watermark-related software program," and "detected watermark"), the appealed action stated only:

*It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize watermark data in Doyle with because it would have enabled distributing copyrighted contents to a plurality of users in the network.*³

The *Answer* slightly revises this proposed rationale – introducing an alleged effectiveness component:

*It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize Moskowitz's teaching in Doyle with because it would have enabled distributing copyrighted contents to a plurality of users in the network more effectively.*⁴

Such rationales evidence hindsight, rather than obviousness. There is no reference to any suggestion in the art leading to the arrangement proposed. There is no reference to any problem with Doyle's system for which Moskowitz proposes a solution. The two references do not even concern the same field of endeavor. Rather, it appears the Office has started with Appellants' claim, and worked backwards to bootstrap a justification.

³ December 3, 2004, Action, page 4, lines 3-6.

⁴ Examiner's Answer, paragraph bridging pages 4-5, emphasis added.

Either of the above two grounds of traverse is sufficient to show that the Office has failed to establish *prima facie* obviousness. Accordingly, the rejection of claim 7 should be reversed.

2. **Claim 8 (§ 103: Doyle + Moskowitz)**

The Office likewise has blurred Doyle's teaching and the language of Appellants' claim 8 to find an overlap. In fact, there is none.

Claim 8 requires that the packet of data transmitted by the claimed apparatus include address information identifying that apparatus.

There is a reference to "addresses" in Moskowitz's specification. It is found in the very first paragraph in column 1, and states:

The watermarks can also serve to allow for secured metering and support of other distribution systems of given media content and relevant information associated with them, including addresses, protocols, billing, pricing or distribution path parameters, among the many things that could constitute a "watermark."

However, this Moskowitz sentence refers to addresses associated with the *media content*. There is no teaching of address information "identifying the apparatus" that sent the packet of data, and there is certainly no teaching of transmitting address information identifying an apparatus in the same packet as an identifier of watermark-related software, as required by claim 8.

Accordingly, even if Doyle and Moskowitz were combined, the invention of claim 8 could not result.

The Answer belatedly acknowledged this gap and tried to redress same by asserting "[I]t should be noted that the address of data content usually comprises address of the content provider or sender because data contents do not exist on their own."⁵ However, no art has been cited for such teaching. It is not included in Doyle or Moskowitz, and the Examiner's unsupported assertion is not art on which a rejection can be fairly sustained.

⁵ Examiner's Answer, page 9, lines 7-9.

The *Answer* also newly cites Moskowitz at col. 9, lines 37-40 for this teaching. However, such reliance is misplaced; Moskowitz does not teach such a limitation. The cited language instead teaches that a Moskowitz watermark can identify the address where *similar* content can be found:

Further a watermark might contain one or more URLs describing online sites where similar content that the buyer of a piece of content might be interested in can be found.

It will be recognized that claim 8 does not call for address information for “online sites where similar content” can be found. Rather, the claim requires address information identifying the apparatus that transmits the data to the remote system.

Again, *prima facie* obviousness has not been established, and reversal of the rejection of claim 8 is thus required.

3. **Claim 9 (§ 103: Doyle + Moskowitz)**

In the *Answer* concerning claim 9, the Office again stretches the art to teach beyond its disclosure. In particular, the *Answer* alleges “Doyle teaches a router.” In support, the *Answer* newly identifies a “program router/launcher (HTML widget)” as the claimed router.⁶

Doyle’s “HTML widget” is HTML code that launches an application program (e.g., a video player) corresponding to the type of content object being processed (Fig. 8). Contrary to the suggestion left by the *Answer*, Doyle does not characterize this “HTML widget” as a “program router/launcher.” That terminology seems to be the Examiner’s own.

Moreover, claim 9 is drawn to an architecture that includes two portions: (a) the apparatus of claim 7; and (b) the remote system. The “router and plural handlers” referenced in claim 9 are specified as being included with the “remote system.” Yet the Doyle arrangement (including the HTML widget of his Fig. 8) are part of the apparatus that the Office contends fulfills the requirements of claim 7. As such, these “router and plural handlers” cannot form part of the “remote system” portion of claim 9. To construe otherwise is to read limitations out of the claim.

Again, the art cannot be combined to yield the arrangement claimed. As such, the rejection of claim 9 does not meet the requirements of § 103 and must be reversed.

4. Claim 10 (§ 103: Doyle + Moskowitz)

As with independent claim 7, the *Answer* continues to cite Doyle for a limitation not present in Appellants' claim 10, and correspondingly fails to identify in Doyle the limitation actually required by that claim.

Doyle teaches that an HTML document can include a tag for each embedded object, specifying the application program that is to be used with each such object.

The Office construes this tag of Doyle as meeting the claimed requirement of "a context or environment identifier." However, it does not. Doyle's tag identifies an application program. Even giving the claim terminology the "broadest reasonable interpretation,"⁷ Doyle does not teach this "context or environment identifier" element of Appellants' claim.

The *Answer* did not address the MPEP passage quoted in Appellants' Brief:

PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification.

Neither in the *Answer*, nor during prosecution, did the Office offer any evidence that, in ordinary usage by an artisan, a "context or environment identifier" would be understood to embrace Doyle's tag, which serves as a "program identifier."⁸

Nor did the *Answer* heed the MPEP's instruction to consider "enlightenment" found in Appellants' written description:

In other cases, an option menu needn't be presented – the correct response is inferred from the context or environment. Consider a drivers' license that is watermarked with identification of the owner. If presented to an email kiosk 12 at an

⁶ Examiner's Answer, page 9, line 14, citing Doyle at col. 14, lines 64-67.

⁷ MPEP § 2111.

⁸ December 3, 2004, Action, page 3, line 12.

airport, the decoded watermark may be used to look-up an email account corresponding to that individual, and download new mail. If the same drivers license is presented to a check-in kiosk, the decoded watermark may be used to look up that person's flight reservation and issue a seat assignment. In both cases the kiosks can be essentially identical. One, however, identifies itself to the router/product handler as an email kiosk, the other as a check-in kiosk. The response undertaken by the router/product handler differs accordingly.⁹

Thus, in the claimed arrangement, the same decoded watermark data is used to achieve different ends, depending on context/environment.

Further "enlightenment" is offered later in Appellants' specification, where different "environments" are described as comprising, *e.g.*, home/office/car, etc:

Primary Information includes the Application Version, Watermark Type, Watermark Serial Number, Context and Environment.

- *Application Version: used by the product handler to modify its actions, typically for backwards compatibility*
- *Watermark Type: top 9 bits of the illustrative watermark payload. Used by the product handler in processing the Watermark Serial Number*
- *Watermark Serial Number: remainder of the watermark payload. Provides the index used by the product handler to access the watermark in the registration database*
- *Context: instructs the product handler to modify/refine its action based on the consumer request's context*
- *Environment: instructs the product handler to modify/refine its action based on the consumer request's environment. (The environment may be specified, *e.g.*, as home, office, car, portable appliance, etc.)*

None of this evidence contrary to the rejection was addressed in the *Answer*. There is no evidence that any artisan would understand Doyle's application-program-specifying tag to comprise the "context or environment identifier" element of Appellants' claim.

Thus, even if Doyle were combined with Moskowitz, the claimed arrangement could not result.

(In addition to impossibility of the art to yield the claimed combination, the *Answer* did not address the noted shortcoming in the rationale-for-combination offered in the appealed rejection. Again, that rationale evidenced hindsight, rather than obviousness. There is no

⁹ Specification, page 25, line 25 – page 26, line 5.

reference to any suggestion in the art leading to the arrangement proposed; there is no reference to any problem with Doyle's system for which Moskowitz proposes a solution; the two references do not even concern the same field of endeavor. Again, the Office started with Appellants' claim, and appears to have worked backwards to bootstrap a justification.)

Any of the foregoing grounds of traverse is sufficient to show that the Office has failed to establish *prima facie* obviousness. Accordingly, the rejection of claim 10 should be reversed.

5. Claim 11 (§ 103: Doyle + Moskowitz)

The *Answer* dismissed arguments noted by Appellants in connection with claim 11, by reference to the *Answer* regarding claim 8.¹⁰ In like fashion, Appellants refer to the points noted above in connection with claim 8, which are equally applicable here.

6. Claim 12 (§ 103: Doyle + Moskowitz)

Similarly, the *Answer* dismissed arguments noted by Appellants in connection with claim 12, by reference to the *Answer* regarding claim 9.¹¹ In like fashion, Appellants refer to the points noted above in connection with claim 9, which are equally applicable here.

7. Claim 13 (§ 102 – Moskowitz)

The *Answer* again takes the Moskowitz disclosure beyond its fair teachings. The *Answer* contends:

*Moskowitz clearly teaches using watermark data to convey contract agreement between two parties such that actual content (video and audio data) delivery can be initiated only after the contract can be agreed upon by both parties (see Moskowitz in col. 9, lines 19-26). For instance, a positive acknowledgement in watermark data sent from the receiver/client would allow the sender/server to initiate data content delivery.*¹²

¹⁰ Examiner's Answer, page 10, lines 18-19.

¹¹ *Ibid.*

¹² Examiner's Answer, middle of page 6. Emphasis added.

But that is not what Moskowitz teaches. He doesn't teach such use of watermark to *initiate* content delivery. Rather, he teaches that content delivery is initiated without regard to watermarks. Instead, watermark information is used to signal that a certain amount of content has been sent. And it teaches that watermark information can be used to signal a disagreement that causes an earlier-initiated content delivery stream to be discontinued.¹³

The passage cited from Moskowitz in the *Answer* is the very one that makes this clear. Column 9, lines 19-26 states:

*The idea is that both sides must agree to what the watermark says, by digitally signing it. The sender agrees they have sent a certain amount of a certain title, for instance, and the receiver agrees they have received it, possibly incurring a liability to pay for the information once a certain threshold is passed. If the parties disagree, the transaction can be discontinued before such time.*¹⁴

Contending (as the *Answer* seems to do) that Moskowitz's decision whether to *discontinue* content delivery anticipates Appellants' claim requirement of *initiating* delivery, is a perversion of Moskowitz's teaching.

Claim 13 is not anticipated by Moskowitz; the rejection should be reversed.

8. Claim 14 (§ 102 – Moskowitz)

Claim 14 was not further addressed in the *Answer* and so is not further addressed here.

9. Claim 15 (New Rejection: § 103 - Moskowitz + Monteiro)

As noted, the *Answer* withdrew the earlier grounds for rejection of claim 15, and made a new rejection based on Moskowitz in view of Monteiro (5,778,187).

Monteiro relates to technology for providing services akin to multi-channel radio or television with commercial programming content adjusted in accordance with the identity of the

¹³ Moskowitz, 5,822,432, col. 8, line 66 – col. 9, line 28 (emphasis added).

¹⁴ Moskowitz, 5,822,436, col. 9, lines 19-26. Emphasis added.

individual user (col. 1, lines 12-15).

Claim 15 is an independent claim that reads as follows:

15. A networked computer system, responsive to watermark data sent from a software program on a remote computer, to initiate delivery of advertisement data to said remote computer.

The *Answer* correctly notes that Monteiro teaches delivering advertisements to users. The *Answer* further correctly notes that Monteiro has no teaching concerning watermark data.

The rejection is flawed, however, in its application of Moskowitz. The *Answer* states:

The use of watermark data in a file for enabling transfer of copyrighted document is well known in the art as disclosed by Moskowitz.¹⁵

This statement impermissibly recharacterizes the claim language. The claim requires a “system, responsive to watermark data ... to initiate delivery of advertisement data.” The *Answer*, however, speaks of “enabling transfer.” “Enabling” is a more generic concept than the specific requirement “responsive to watermark data to initiate” used in Appellants’ claim.

Moskowitz does not teach a system responsive to watermark data to “initiate” delivery of any content. Rather, Moskowitz teaches arrangements in which watermark data is simply delivered *with* content; initiation of such delivery is not responsive to any watermark data.

The Moskowitz excerpt cited in the *Answer* (col. 8, line 54 – col. 9, line 40) does not support the rejection. That excerpt does not teach *initiation* of any delivery. Rather, this 50+ line excerpt addresses other Moskowitz teachings (*e.g.*, the possibility of embedding watermark decoders in search agents/viruses/automated archived scanners; online services that refuse to archive audio which does not contain a valid watermark notarized by a digital notary; using watermarks to effect content metering services – in which successful delivery of content to a user is confirmed by reference to successfully decoded watermark data; watermarks that encode geographical or other distribution restrictions; and watermarks that indicate where other copies of the same or similar content are located.)

¹⁵ Examiner’s Answer, page 5, lines 15-17.

Some of this disclosure might satisfy the generic “enabling transfer” language used in the *Answer* (e.g., a watermark indicating where content is located might be regarded as “enabling transfer” of such content). However, none of Moskowitz’s disclosure teaches a system responsive to watermark data to initiate delivery of content, as required by claim 15.

Thus, even if the teachings of Moskowitz and Monteiro were combined, the arrangement of claim 15 could not result.

Moreover, the claim requires that the “remote computer” play roles akin to both pitcher and catcher. The watermark data is sent “from a computer program on a remote computer” and initiates delivery of advertisement data “to said remote computer.” No such arrangement is taught or suggested by the cited art.

(Additionally, the rationale offered in the *Answer* in support of combining Monteiro and Moskowitz is inadequate – premised on the assertion that an artisan would be led to combine “*because it would have enabled distributing copyrighted contents to a plurality of users in the network more effectively.*”¹⁶ A motivation to combine generally requires recognition of a particular problem, coupled with an obvious realization that the problem can be addressed by borrowing teachings from another reference. Here, there is no showing of any problem with either reference. Rather, the combination seems to have been guided by hindsight – with reference to Appellants’ claim.)

In view of the foregoing points, the new rejection of claim 15 does not establish *prima facie* obviousness, and should be reversed.

10. Claim 16 (New Rejection: § 103 - Moskowitz + Monteiro)

The earlier rejection of claim 16 was also withdrawn in the *Answer*, and a new rejection based on Moskowitz in view of Monteiro has been made.

Claim 16 is parallel to just-discussed claim 15, but is drawn to initiating delivery of “updated software” to the remote computer:

¹⁶ Examiner’s Answer, sentence bridging pages 5-6.

16. (Original) *A networked computer system, responsive to watermark data sent from a software program on a remote computer, to initiate delivery of updated software to said remote computer.*

The new rejection of claim 16 shares all the shortcomings of the rejection of claim 15, discussed above, and the rejection should similarly be reversed.

Moreover, claim 16 is patentable independently of claim 15 because of the requirement that the watermark data initiate delivery of "updated software" to the remote computer.

In Monteiro's content delivery system, the client and server compare the respective version numbers of software they are running. If they don't match, it is generally of no consequence – "*in most cases the current transaction can be completed since the software systems are designed to be fully backward compatible with previous versions.*" (Col. 11, lines 58-61.) If the server is the Administrative Server, the client is informed that a software update is needed, and an automatic update procedure may be invoked (col. 11, lines 61-66). However, the update procedure is triggered upon discovering a software version mismatch between the client and the Administrative Server. An artisan following such instruction from Monteiro would not arrive at the different arrangement detailed in Appellants' claim 16.

Again, the new rejection does not meet the Office's burden under § 103 and must be reversed.

V. CONCLUSION

The rejections under § 102 fail because the art does not teach each of the claims' limitations. The rejections under § 103 fail because the Office has not established *prima facie* obviousness. Accordingly, the Board is requested to reverse all of the outstanding rejections, and remand to the Examiner for issuance of a notice of allowance.

Date: September 27, 2005

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Respectfully submitted,

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